

REMARKS

With the entry of the present amendments, claims 1-4, 6-8, 10, 11, 16, 18, 20, 28, 37-39, 41, and 49-62 are pending in the application. Claims 5, 9, 19, 25, 27, 29, 30, 35 and 43 are cancelled with the entry of the present amendments. Claims 12-15, 17, 21-24, 26, 31-34, 36, 40, 42 and 44-48 were previously cancelled. Claims 1, 6-8, 18, 28, 37-39, and 41 have been amended. New claims 49-62 have been added. Support for the claim amendments and new claims may be found throughout the application as filed including, but not limited to:

Claims 1, 6, 7 and 39: Claim 7, as originally filed; paragraph [0018]; Table 1 and Table 2.

Claim 8: Claim 8 as originally filed. (This amendment is included merely to correct the grammar of the claim.)

Claims 18, 28, 37 and 38: Claims 18, 28, 37 and 38 as originally filed. (These amendments merely change the claim dependencies.)

Claims 49-62: See discussion in Section III below.

In view of the following remarks reconsideration and withdrawal of the rejections to the application in the Office Action is respectfully requested.

I. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a), IN VIEW OF U.S. PATENT NO. 6,485,794.

In the Final Office Action, claims 1-11, 16-20, 25-30, 35-39, 43 and 45-48 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,485,794 issued to Li, et al. (hereinafter “Li”). In the Advisory Action, these claim rejections were maintained. Applicants respectfully traverse.

In the pending rejections the Examiner maintains that, because the Li compositions may be cured by visible light and fluorescent lamps, Li teaches lubricating compositions that are non-thermally and non-radiatively cured. Applicants respectfully disagree with the Examiner’s position. However, in order to expedite the prosecution of the application, Applicants have amended the claims in compliance with the Examiner’s recommendations in the telephone conference of November 17, 2005. In view of these amendments Applicants respectfully submit that the claims are now in condition for allowance.

In the telephone conference of November 17, 2005, the Examiner suggested amending the claims to define the lubricant composition in terms of the monomeric make-up of the polymers, rather than their curing properties. Specifically, the Examiner suggested amending the claims to include the limitation that the lubricating coatings included polymers made from styrenic monomers. The Examiner stated that, provided the publications incorporated by reference in column 3 of Li did not teach lubricating coating containing styrenic monomers, such amendments would render the claims allowable. Applicants thank the Examiner for highlighting this distinction.

In compliance with the Examiner's recommendation, Applicants have amended independent claims 1 and 39 to include the limitation that the hydrophobic polymer and/or the alkali soluble resin of the lubricant coating "is polymerized from monomers that include (a) styrenic monomers and (b) at least one monomer selected from the group consisting of acrylate monomers, methacrylate monomers, methacrylic acid monomers and acrylic acid monomers." Li does not teach or suggest a coating made from such polymers. None of the film formers listed in column 3 of Li include styrenic monomers. Moreover, the only publication incorporated by reference in column 3 of Li that mentions styrene-containing polymers is U.S. Patent No. 5,830,937 (hereinafter "the '937 Patent"). However, this references does not teach a polymer polymerized from styrenic monomers *and* at least one monomer selected from the group consisting of acrylate monomers, methacrylate monomers, methacrylic acid monomers and acrylic acid monomers.

The '937 Patent teaches a coating made from a thermoplastic polymer and a crosslinking agent. (See col. 3, lines 23-26.) The thermoplastic polymer is a vinyl chloride polymer that may include styrene monomers. (See col. 14, lines 19-21 and 28-35.) The '937 Patent does not teach a vinyl chloride polymer made from styrenic monomers *and* at least one monomer selected from the group consisting of acrylate monomers, methacrylate monomers, methacrylic acid monomers and acrylic acid monomers. (See col. 10, lines 39-43.) The '937 Patent does describe acrylate ester monomers and oligomers, but only as crosslinking agents, *not as part of the thermoplastic polymer*. Thus, even if the thermoplastic polymers of the '937 Patent were used as a film former in the methods of Li, those methods would not include the step of applying a polymer that

includes both styrenic monomers *and* at least one monomer selected from the group consisting of acrylate monomers, methacrylate monomers, methacrylic acid monomers and acrylic acid monomers to a conveyor part. Therefore, Li does not render the pending claims obvious because Li fails to teach or suggest each limitation of the amended claims. For this reason Applicants respectfully request that this rejection be withdrawn.

II. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a), OVER PCT PATENT PUBLICATION NO. WO 92/19505 IN VIEW OF LI.

In the Final Office Action, claims 1-5, 10, 11, 18-20, 45, 46 and 48 were rejected under 35 U.S.C. § 103(a) as unpatentable over WO 92/19505 in view of Li. In the Advisory Action these claim rejections were maintained. Applicants respectfully traverse.

In the pending rejection the Examiner maintains that, in view of the teachings of Li, it would have been obvious to apply the bottle coating of WO 92/19505 to a conveyor. Applicants respectfully disagree with the Examiner's position. However, in order to expedite the prosecution of the application, Applicants have amended independent claims 1 and 39 to include the limitation from original claims 5 (now cancelled) that the lubricating coating contains an alkali soluble resin. The Examiner did not reject original claim 5 over WO 92/19505 in view of Li. Therefore, in view of the present amendments Applicants respectfully submit that the claims are now in condition for allowance and respectfully request that this rejection be withdrawn.

III. NEW CLAIMS 55-62.

New claims 55-62 have been added to the application. These claims are directed to methods for lubricating a conveyor by applying a liquid composition comprising a hydrophobic polymer and an alkali soluble resin to a conveyor part, wherein the hydrophobic polymer and the alkali soluble resin do not undergo polymerization or crosslinking after application to the conveyor part.

The negative limitation that the hydrophobic polymer and the alkali soluble resin do not undergo polymerization or crosslinking after application to the conveyor part is supported by the specification and, as such, complies with the written description requirement under 35 U.S.C. § 112, first paragraph.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. However, if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See MPEP 2173.05(i). In addition, a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. See MPEP 2173.05(i), relying on *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

Drying and polymerizing are positively recited as alternative forms of hardening in paragraph [0013] of the specification, therefore the negative limitation explicitly excluding polymerization, in new claims 55-62, does not violate the written description requirement of 35 U.S.C. § 112, first paragraph (MPEP 2173.05(i)).

In addition, the holding in *Ex parte Parks* supports the conclusion that the lack of a literal basis for the negative limitation explicitly excluding polymerization and crosslinking of the hydrophobic polymer and the alkali soluble resin after application, as recited in new claims 55-62, is not sufficient to establish a *prima facie* case for lack of descriptive support. In *Ex parte Parks*, the Board reviewed an appeal from a final rejection of claims in a reissue application. The claims under examination recited a method for determining the nitrogen content of a sample and included the step of decomposing the sample in the absence of a catalyst. (*Ex parte Parks* at 1235.) In the final rejection the claims were rejected under 35 U.S.C. 112, first paragraph for lack of adequate descriptive support because the negative limitation “in the absence of a catalyst” had no literal basis in the specification. (*Ex parte Parks* at 1236.) The Board reversed the rejection stating, “Adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the invention. ... Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.” (*Ex parte Parks* at 1236.) The Board based their decision on the fact that throughout the discussion “which would seem to cry out for a catalyst if one were used,” no mention was made of a catalyst, and on the fact that one having ordinary skill in the art would have recognized that the decomposition was conducted without a catalyst. (*Ex parte Parks* at 1236.)

The facts of the present application are analogous to those of Ex parte Parks. Throughout the present specification the discussion describes the application of fully polymerized polymers to a conveyor part. There is no mention of crosslinking in the specification. In fact, as one of skill in the art would recognize, the types of polymers described in the pending application would not undergo crosslinking without the use of crosslinking agents, high temperatures, or both. Therefore, if the disclosure were intended to cover lubricating coatings formed by post-application crosslinking, the present specification would seem to cry out for a crosslinking agent and a post-application heat treatment step. The absence of such a disclosure reflects the fact that the lubricating coatings described and exemplified in the specification are formed without post-application polymerization or crosslinking, as one of skill in the art would recognize. Therefore, despite the lack of literal support for the negative limitation that the hydrophobic polymer and the alkali soluble resin do not undergo polymerization or crosslinking after application to a conveyor part, the originally-filed disclosure would clearly convey to one of ordinary skill in the art that Applicants had possession of the invention of new claims 55-62 at the time of filing.

In view of the foregoing remarks, Applicants respectfully submit that all of the claims remaining in the application are in condition for allowance and favorable action thereon is respectfully solicited.

Respectfully submitted,

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